

REMARKS AND ARGUMENTS

A. The Applicant Requests Reconsideration and Allowance of the Application

The applicant urges that the prosecution of this application, which will now be up for its *sixth* Office Action, be concluded with an allowance of all pending claims. See M.P.E.P. § 707.02 (“The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.”).

No requests for continued examination have been filed in this case, and the case has not been heard by the Board of Appeals. Instead, the Office has been unable to establish a *prima facie* case of obviousness against the pending claims. Under the patent statute, an applicant is “entitled to a patent *unless*” the Office can show that the conditions for patentability have not been met. 35 U.S.C. § 102 (emphasis added); *see also* §§ 101, 103. “The Patent and Trademark Office (PTO) has the burden of showing a *prima facie* case of obviousness.” *In re Mayne*, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997). Since the Office has been unable to make such a showing, the applicant requests a prompt allowance of the claims.

Until this response, which is designed to bring the prosecution of the case to a prompt conclusion, the claims in this application had not been amended for the last two years. *See* Response (Jan. 8, 2007). Nonetheless, *four* Office Actions were then issued against the exact same claims, each Office Action replacing one ground of rejection with another.

- “Applicant’s amendment necessitated the new ground(s) of rejection.” O.A. (Mar. 21, 2007) p. 8.
- “Applicant’s arguments ... are persuasive. Therefore, the rejection has been withdrawn. However ... a new ground(s) of rejection is made.” O.A. (Nov. 29, 2007) p. 10.
- “The rejection is withdrawn.” Pre-Br. App. Conf. Dec. (Apr. 17, 2008).
“Applicant’s arguments ... are moot in view of the new ground(s) of rejection.” O.A. (Jun. 26, 2008) p. 9.
- “Applicant’s arguments ... have been fully considered and are persuasive.... However, upon further consideration, a new ground(s) of rejection is made.” O.A. (Oct. 6, 2008) p. 2.

The most recent Office Action does not rely on any newly-uncovered prior art. All of the art relied on had been cited at least three Office Actions ago, even though the examiner has performed at least two updated searches since then. *See* Search Notes of Jun. 26 and Oct. 6, 2008.

After the present set of claims was presented, the PTO made three attempts to establish a *prima facie* case of obviousness against those claims, and it has withdrawn all three of them. Because the PTO was unable to establish any case of unpatentability, the applicant is “entitled to a patent” under the patent laws. *See* 35 U.S.C. 102, 103. But instead of allowing the claims, the PTO has issued yet a fourth rejection of the same claims, using the same prior art as in prior rejections. Like its predecessors, the latest rejection fails to address all elements of the claims, and it fails to respond to the applicant’s arguments for patentability.

Office Actions are required to be “complete as to all matters,” 37 C.F.R. § 1.104(b). “All words in a claim must be considered in judging the patentability of that claim.” M.P.E.P. § 2143.03. But this fourth rejection of the pending claims *still* does not address all the limitations of those claims.

- The new rejection against claim 28 does not even mention the claimed limitation of “determin[ing] an expected delay for the delivery of the electronic message.” *See* O.A. pp. 2-3.
- Two years ago, the applicant first pointed out that the rejection did not identify the claimed “subscriber data storage” in the prior art. *See* Response (Jan. 8, 2007). Four rejections later, the Office Action *still* does not identify any “subscriber data storage.”
- Three rejections ago, the applicant pointed out that the rejection did not identify the claimed step of sending a message “to the message gateway” in the prior art. *See* Response (May 21, 2007) p. 11. The Office Action *still* does not identify this step.
- In the last response, the applicant pointed out that the rejection did not identify in the prior art a delay query that “include[s] a threshold delay” as claimed. *See* Response (Sept. 5, 2008) p. 9. The latest Office Action still does not identify a delay query that “include[s] a threshold delay.”
- The rejections have not identified in the prior art the claimed “message senders that subscribe to receive delay reports.” Instead, the examiner claims to have been told “by the Applicant” that Jiang discloses a “subscriber . . . in direct accordance with the claimed language of the Applicant’s invention.” O.A. pp. 4-5. But the applicant has made no such statement.

Patent Office procedures call for a substantive response to the applicant's traversal of claim rejections. *See* M.P.E.P. § 707.07(f) ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."). But the PTO has not indicated what areas of disagreement remain.

- Claims 28-31 were previously rejected in view of Chung Kam Chung and Jiang. *See* O.A. (Mar. 21, 2007). The applicant *successfully* traversed those rejections. *See* O.A. (Nov. 29, 2007) p. 10 ("the rejection has been withdrawn"). But in the latest Office Action, the examiner rejected those claims *again* in view of Chung Kam Chung and Jiang, without addressing the applicant's earlier successful argument.

- The latest Office Action repeats the obviousness rejections of claims 1-14, 16-21, 23, and 25-27 from the previous Office Action (June 26, 2008). The applicant has already argued that those rejections were erroneous in several respects, *see* Response (Sep. 5, 2008), but the examiner has not answered or even acknowledged those arguments.

In summary, the Office Action does not identify all claim limitations in the prior art, and it does not identify any disagreement with the applicant's arguments. Where the PTO cannot establish a *prima facie* case of obviousness, there is no basis for the continued rejection of the claims, and the applicant is entitled to a Notice of Allowance. *See* 35 U.S.C. 102, 103.

B. The Applicant Has Attempted to Focus the Issues in this Case

In this response, the applicant has amended the claims only to focus the issues in this case and to bring the prosecution of the application to a prompt conclusion. Independent claim 14 has been amended to incorporate the subject matter of claim 15, which the examiner indicated would be allowable. Accordingly, claim 14 and its dependent claims 16-21 should be allowed. Claim 31 has been rewritten in independent form, and its original base claim, claim 30, has been canceled.

C. The Applicant Preserves all Arguments

Because the PTO has not answered the substance of the applicant's previous arguments, it is unclear which arguments the PTO has accepted. To preserve the applicant's rights in case of an appeal—but more importantly to avoid the need for an appeal—the applicant preserves all arguments as to the patentability of the pending claims, including, without limitation, the following points.

1. The Newly-Entered Rejections of Claims 28, 29, and 31
Did not Address all Claim Limitations

a. The Rejection Does not Discuss a “Delay Query” that Includes a “Threshold Delay”

The obviousness rejections of claims 28, 29, and 31 should be withdrawn because the rejections do not consider all claim limitations. Claims 28, 29, and 31 require the use of a “delay query” that *includes* “a threshold delay.” See claim 28. But nowhere in the obviousness rejections of these claims is there any contention that the prior art discloses a “threshold delay” that is included in a delay query. See O.A. pp. 2. This claim element appears not to have been considered in the examination. Even though the *only* limitation in the body of claim 31, as examined, was that “the delay query includes the threshold delay,” the rejection of claim 31 makes no mention of whether any alleged “delay query” includes a “threshold delay.” Instead, the rejection discusses subject matter unrelated to claim 31.

Regarding **claim 31**, as the combination of Jiang et al., Ament and Chung Kam chung et al. are made, the combination according to **claim 30**, Chung Kam chung et al. further discloses wherein the delay report is sent in response to the determination that the expected delay has fallen below the threshold delay. See column 7 lines 59-67 and column 10 lines 36-65.

See O.A. p. 4. Because the Office Action does not address the claim limitation of a delay query that includes “a threshold delay,” no *prima facie* case of obviousness has been established against claims 28, 29, or 31. The rejections of those claims should be withdrawn, and the claims should be allowed.

b. The Rejection Does not Discuss Determining a Delay for “Delivery of an Electronic Message”

Independent claim 28 recites a system that operates “to determine an expected delay for the delivery of the electronic message.” The rejection of claim 28 does not even mention this limitation. Accordingly, no *prima facie* case of obviousness has been established against claim 28 or its dependent claim 29. See O.A. p. 2-3.

2. The Repeated Claim Rejections Fail to Establish Obviousness

Previously-presented claims 1-13, 23, and 25-27 were again rejected as being obvious under 35 U.S.C. § 103(a) in light the combination of Published U.S. Patent Application No. 2005/0096059 (“Jiang”), Published U.S. Patent Application No. 2004/0105436 (“Ament”) and U.S. Patent No. 6,606,502 (“Chung Kam Chung”). The applicant again traverses these rejections.

a. Not all Limitations of Claims 23 and 25-27 Have Been Considered

Claim 23 recites a system that includes a “subscriber data storage.” No Office Action has yet identified where, if at all, the prior art relied on is alleged to disclose any subscriber data storage that operates as described in claim 23. Accordingly, no *prima facie* case of obviousness has yet been established against claim 23, and the rejection of claim 23 and its dependent claims 25-27 should be withdrawn.

b. Chung Kam Chung Does not Disclose Sending Messages to an Electronic Gateway when the Delay Is Sufficiently Low

Independent claim 1 recites the step of “sending the electronic message to the message gateway.” In this step, the messages is sent “to the message gateway only after determining that the expected delay is less than the threshold delay.” *See* claim 1. The examiner recognizes that this step is not disclosed by Jiang or Ament. *See* O.A. p. 6. The examiner alleges that Chung Kam Chung discloses *part* of this claim step:

Chung Kam chung et al. discloses in column 10 lines 39-57 and column 11 lines 1-25 whereby the expected delay is less than a threshold delay, therefore transmitting the said messages.

O.A. p. 6. But claim 1 does not recite that the message is transmitted or sent just *anywhere* after the delay is sufficiently low; claim 1 recites that the message is sent “to the message gateway” if the delay is sufficiently low. The Office Action does not identify where, if at all, the prior art discloses that a message could be sent “to the message gateway” only after the delay is sufficiently determined to be sufficiently low. Accordingly, no *prima facie* case of obviousness has been established against claim 1 or its dependent claims 2-13. The rejections of those claims should be withdrawn, and the claims should be allowed.

c. The Office Action Relies on two Contradictory Interpretations of the Chung Kam Chung Disclosure

With respect to claim 1, the examiner correctly recognizes that “the combination of Jiang et al. and Ament fails to clearly disclose” two of the features of claim 1. See Office Action (O.A.) p. 6. Namely, the examiner agrees that the following features are not found in a combination of Jiang and Ament:

based on the delay report, determining, at the message sender, whether the expected delay is less than a threshold delay; and
sending the electronic message to the message gateway only after determining that the expected delay is less than the threshold delay.

Claim 1 (paraphrased at O.A., p. 6). To complete the rejection of claim 1, the examiner relies on Chung Kam Chung as disclosing these elements. However, the Office Action states two contradictory positions on the same portion of the Chung Kam Chung reference. In particular, the examiner’s interpretation of Chung Kam Chung with respect to claim 1 contradicts the examiner’s own interpretation with respect to the rejection of claim 8.

In making the rejection of claim 1, the examiner contends that Chung Kam Chung discloses the claim elements not found in Jiang or Ament:

Chung Kam [C]hung et al. discloses in column 10 lines 39-57 and column 11 lines 1-25 whereby the expected delay is less than a threshold delay, therefore transmitting *the said messages*.

O.A., p. 6 (emphasis added). That is, Chung Kam Chung is alleged to disclose that the transmission of the claimed *message* depends on the expected delay level. But in the rejections of other claims, the same feature of Chung Kam Chung is alleged to disclose that the transmission of the claimed *delay report*—not the transmission of the electronic message—depends on the expected delay level:

Chung Kam [C]hung et al. disclose wherein the expected delay has fallen below a threshold delay, wherein the *delay report* is sent in response to the determination that the expected delay has fallen below the threshold delay. See column 7 lines 59-67 and column 10 lines 36-65.

O.A., p. 8-9 (emphasis added). These two interpretations of Chung Kam Chung are mutually contradictory. In claims 1 and 8, a “message” is sent *from* a user and a “delay report” is sent *to* a user, but the same feature of Chung Kam Chung is alleged to disclose both of these limitations.

Thus, at least one of these interpretations of Chung Kam Chung is incorrect. The applicant respectfully submits that they are *both* incorrect. As the applicant has shown previously, Chung Kam Chung does not “disclose that an electronic message can be sent to a message gateway only after determining that the expected delay is sufficiently short.” *See* Response (mailed May 21, 2007), p. 9. Whether Chung Kam Chung is interpreted as sending an “electronic message” or as sending a “delay report,” in neither case does this “sending” depend on whether or not an expected delay has fallen below a threshold.

Because neither of these interpretations of Chung Kam Chung is correct, claims 1 and 8, whose rejections depend on these two different interpretations, should be allowed. In any event, if the examiner interprets Chung Kam Chung so as to reject claim 1, the contradictory rejections of claims 8 and 25 cannot stand, and vice versa.

d. The Ament Reference Does not Disclose a “Message Gateway”

Claim 1 and its dependent claims 2-13, and claims 26, and 27 all include a “message gateway” limitation. The rejection of all claims relies on the examiner’s contention that the “application (8)” of Ament is a “message gateway” as claimed. O.A., pp. 3-4. The applicant respectfully disagrees and traverses these rejections.

According to the examiner, the “application (8)” of Ament is the claimed “message gateway,” from which “the messages are sent.” O.A. p. 5. But Ament provides little more information on “application 8” than the fact that it is an “application program” par. [0041], i.e., “a piece of software that can be executed on a control unit” par. [0003]. Ament never suggests that the “application 8” could be a message gateway. To the contrary, Ament makes it clear that his system is intended to be used in the transportation industry:

Such resource management methods are used in connection with methods of transport, for example aircraft, motor vehicles and others, and are either stored centrally in a resource control unit or are provided distributed over a plurality of control units. In connection with motor vehicles, resources of the data bus itself, i.e. its engagement and free channels and resources of the telematics system are both managed, with the telematics system being connected to the data bus in distributed form. In this case, resources of navigation systems, radio receivers, television receivers and telephone-linked diagnostic and software systems are managed.

Par. [0004].

The examiner contends that “messages are sent” when the “application 8” of Ament is in a “use phase”:

[A]pplication (8) . . . uses the information from the said resource manager in the “use” phase (15). It is here in the use phase (15), as interpreted by the Examiner, that ***the messages are sent*** and processed according to the information received from the said resource manager (1).

O.A., p. 5 (emphasis added). But there is no disclosure of messages being sent during this “use phase.” Ament’s ***entire*** description of the “use phase” is in one sentence, which makes no mention of sending messages.

Following the request process for the service, the application 8 uses the requested resource during the use phase 15.

Par. [0043].

Because Ament does not disclose a “message gateway,” no *prima facie* case of obviousness has been established against claims 1-13, 26, or 27. The rejections of those claims should be withdrawn and the claims should be allowed.

e. There Is no Reason to Combine Ament with the Other References

The rejections of claims 1-13, 23, and 25-27 all rely on a combination of Ament with the other references, Jiang and Chung Kam Chung. But the Office Action offers no plausible explanation of how or why Ament would be combined with these other references, which are in different technical fields altogether. Jiang and Chung Kam Chung both relate to wireless telecommunications. *See* Jiang, Abstract (“[a] method of wireless communication”); Chung Kam Chung, Abstract (“In a cellular telecommunications network, a method and system. . .”). Ament, on the other hand, operates a data bus that is used to allocate resources such as “navigation systems, radio receivers, television receivers and telephone-linked diagnostic and software systems.” Par. [0004].

The examiner reasons that it would be obvious to add the transportation electronics of Ament to the other references “in order to provide a central device (resource manager) that determines the expected delay of an electronic message being requested to be transmitted by a said subscriber/user.” O.A. p. 6. This reasoning does not hold up. In particular, nothing in the Ament disclosure suggests that any expected delay is being determined. The examiner notes that Ament’s term “resource conflict” is “interpreted by the Examiner as delay,” O.A. p. 6, but

Ament himself explains that “resource conflict” simply means that “a requested resource has already been engaged.” Par. [0021]. Thus, even if Ament did disclose a “message gateway,” the Office Action would nevertheless fail to present a *prima facie* case of obviousness. *See* MPEP § 2143.01.

f. Jiang Does not Disclose Determining a Delay for Delivery of an Electronic Message

The rejections of claims 1-13, 23, and 25-27 rely on the examiner’s contention that Jiang discloses a step of “determining an expected delay for delivery of an electronic message.” O.A. p. 4. In Jiang, however, the delay mentioned is not a delay in the delivery of an electronic message, but rather a delay in the time it takes to gain access to a network.

For the purposes of the present disclosure, the delay may correspond with a time interval between a first instant that a subscriber initiates a service request to a provider’s network—or, in the alternative, the instant when a service request is autonomously initiated at a predefined (e.g., periodic or aperiodic) moment in time—and a second instant in which service access is granted to the subscriber.

Par. [0015]. Nothing in the Jiang disclosure suggests that Jiang determines the expected delay for delivery of an electronic message. The examiner apparently recognizes that there is no such disclosure in Jiang, because the examiner broadly argues that “the user is able” to send information “when the service is available.” O.A. p. 5 (emphasis added). This is like arguing that the expected delay for delivery of first-class mail is determined by what time the Post Office opens in the morning. Clearly, Jiang does not disclose any step of determining an expected delay for delivery of an electronic message.

g. Jiang Does not Disclose Determining Whether an Expected Delay is Less than a Threshold

The new rejections of claims 28, 29, and 31 depend on the assertion that Jiang discloses a step of “determining whether an expected delay for delivery of an electronic message is less than a threshold delay.” *See* O.A. p. 2. But previously, in rejecting the same, un-amended claims, the Examiner stated that Jiang does **not** disclose this feature. In the Office Action of November 29, 2007, the examiner noted that “the combination of Jiang et al. and Ament fails to clearly disclose . . . determining at the subscriber/user whether the information presented is less than a predetermined threshold delay,” O.A. (Nov. 29, 2007) p. 4, and the examiner was required to cite

yet another reference to show “the expected delay is less than a threshold delay.” *Id.* The examiner was right the first time: Jiang makes no reference whatsoever to a threshold delay, nor does Jiang compare any expected delay to a threshold delay. Accordingly, no *prima facie* case of obviousness has been established against claims 28, 29, or 31.

D. Conclusion

Because the prior art relied on does not disclose all features recited in the independent claims, and the Office Action therefore does not raise a *prima facie* case of obviousness against those claims. The dependent claims distinguish over the prior art for at least the reasons given for their respective independent claims. For these reasons and those recited in previous responses, the applicant requests prompt allowance of the claims.

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